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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,350	07/18/2003	Thomas P. McAuliffe	07561.0036-00000	5031
22852 7590 01/09/2008 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER NAJARIAN, LENA	
			ART UNIT 3626	PAPER NUMBER
			MAIL DATE 01/09/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/623,350	<b>Applicant(s)</b> MCAULIFFE, THOMAS P.	
	<b>Examiner</b> Lena Najarian	<b>Art Unit</b> 3626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20040812</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 1 is objected to because of the following informalities: step 3 is labeled "(D)". The Examiner suggests Applicant change step 3 to "(C)".  
Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 9 recites that there is no correlation between the user and the identifier kept by the website. It is unclear to the Examiner how the appropriate advice is delivered to the user if no identifier is kept by the website. Claim 10 recites the use of an answer key in which the text of the answers is not shown. It is unclear to the Examiner how to differentiate between the keys if there is no text. Clarification is required.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3-5, 7, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Hickford et al: (US 2002/0147641 A1).

(A) Referring to claim 1, Hickford discloses a method for determining the degree to which a user complies with a health maintenance program, comprising (para. 24 and para. 25 of Hickford):

(A) providing a plurality of prevention elements (para. 24 of Hickford);

(B) weighting the prevention elements relative to one another (para. 32 and para. 48 of Hickford);

(C) determining to what extent the user complies with each prevention element (para. 51 and para. 26 of Hickford); and

(D) determining an overall preventative maintenance score for the user based on the extent to which the user complies with each prevention element (para. 50 and para. 51 of Hickford).

(B) Referring to claim 3, Hickford discloses wherein the health maintenance program is directed to the prevention of a particular disease (para. 32 of Hickford).

(C) Referring to claim 4, Hickford discloses a method for providing health maintenance advice, comprising (para. 5 of Hickford):

(A) receiving a subscription from a user (para. 24 of Hickford);

(B) sending a health maintenance program to the user without receiving any personal health information from the user, wherein the health maintenance program includes multiple versions (para. 32 and para. 48 of Hickford); and

(C) permitting the user to select from the multiple versions a version that is customized to the user according to the user's personal health information (para. 24 and para. 32 of Hickford).

(D) Referring to claim 5, Hickford discloses receiving certain non-private information from the user, and step (B) includes sending the user a particular health maintenance program based on said non-private information (para. 24 of Hickford).

(E) Referring to claim 7, Hickford discloses wherein the user's personal health information includes at least one of lifestyle habits, family history, physical state, mental state, and symptoms (para. 24 of Hickford).

Insofar as the claim recites "at least one of," it is immaterial whether or not all elements are disclosed.

(F) Referring to claim 11, Hickford discloses a method for providing personalized advice via a website, comprising (para. 46 of Hickford):

(A) receiving a subscription from a user (para. 24 of Hickford);

(B) sending an advice program to the user, the advice program requiring the user to answer certain questions, the answers to which are used to generate personalized advice to the user (para. 32 and para. 48 of Hickford);

(C) providing a webpage for receiving the user's answers, wherein the webpage cannot be effectively utilized without having the advice program (para. 26 and para. 27 of Hickford); and

(D) generating personalized advice for the user according to the user's answers (para. 24 of Hickford).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hickford et al. (US 2002/0147641 A1).

(A) Referring to claim 2, Hickford discloses counting points in order to determine whether performance targets were met (see para. 24 - para. 26 & para. 48 of Hickford). Hickford does not expressly disclose wherein more heavily weighted prevention elements impact the overall preventative maintenance score more than less heavily weighted prevention elements. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize

the aforementioned method of calculation with the motivation of providing a score that is proportional to what is necessary for proper prevention of certain conditions.

(B) Referring to claim 9, Hickford discloses a method for providing personalized advice via a website, comprising (para. 46 of Hickford):

(A) receiving a subscription from a user via a website (para. 24 of Hickford);

(B) sending an advice program to the user, the advice program including an identifier corresponding to the program sent to the user, wherein no correlation between the user and the identifier is kept by the website (para. 32 and para. 48 of Hickford);

(C) providing a scoring webpage for the user, wherein the identifier is used to determine the particular advice program sent to the user, and the user is prompted to enter its answers on the website (para. 25 and para. 26 of Hickford); and

(D) generating personalized advice for the user according to the user's answers (para. 24 of Hickford).

While Hickford does disclose collecting information for the user (see para. 26 of Hickford), Hickford does not expressly disclose including questions and answers calling for personal information from the user. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include the aforementioned method of gathering data in order to elicit pertinent information for the analysis.

(C) Referring to claim 10, Hickford discloses wherein step (C) includes the use of an answer key in which the text of the answers is not shown (para. 33 of Hickford).

9. Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hickford et al. (US 2002/0147641 A1) in view of Douglas et al. (6,039,688).

(A) Referring to claim 6, Hickford does not disclose wherein the non-private information includes at least one of age and gender.

Douglas discloses wherein the non-private information includes at least one of age and gender (col. 7, lines 23-28 of Douglas).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the aforementioned feature of Douglas within Hickford. The motivation for doing so would have been to generate a set of customized goals or milestones (col. 7, lines 23-28 of Douglas).

(B) Referring to claim 8, Hickford does not disclose wherein the multiple versions include a basic, intermediate, and aggressive version.

Douglas discloses intensity levels (see col. 7, lines 15-22 of Douglas).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the aforementioned feature of Douglas within Hickford. The motivation for doing so would have been to provide various levels for the different requirements of the patients (col. 7, lines 15-22 of Douglas).



10. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hickford et al. (US 2002/0147641 A1) in view of Neuman (US 2003/0158755 A1).

(A) Referring to claim 12, Hickford discloses a method for providing health maintenance advice, comprising (para. 24 of Hickford):

(A) sending a plurality of health maintenance programs to a user, each health maintenance program including a plurality of prevention elements (para. 32 and para. 48 of Hickford).

Hickford does not disclose:

(B) informing the user as to one or more conflicts between prevention elements from different programs.

Neuman discloses informing the user as to one or more conflicts between prevention elements from different programs (para. 5 of Neuman).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the aforementioned feature of Neuman within Hickford. The motivation for doing so would have been to communicate possible complications (para. 5 of Neuman).

(B) Referring to claim 13, Hickford does not disclose wherein one or more conflicts include a prevention element that is a potential benefit for one health maintenance program while a negative for another health maintenance program.

Neuman discloses wherein one or more conflicts include a prevention element that is a potential benefit for one health maintenance program while a negative for another health maintenance program (para. 5 of Neuman).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the aforementioned feature of Neuman within Hickford. The motivation for doing so would have been to communicate possible complications (para. 5 of Neuman).


### ***Conclusion***

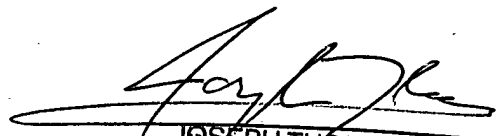
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art teaches a scientific wellness personal/clinical/laboratory assessment (5,692,501).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lena Najarian whose telephone number is 571-272-7072. The examiner can normally be reached on Monday - Friday, 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
In  
1-4-08

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER